



IN THE UNITED STATES PATENT OFFICE  
BOARD OF PATENT APPEALS & INTERFERENCES

#39  
10/1  
JLR  
9/14/04

In re Application of W. Roy  
KNOWLES, M.D.

Docket No. \_\_\_\_\_  
Application No. 09/619,142  
filed 19 July 2000

REPLY BRIEF

SEP - 8 2004

TECH CENTER 1600/2900

REPLY BRIEF

This REPLY BRIEF is submitted in response to the 1 July 2004 SUPPLEMENTAL EXAMINER'S ANSWER.<sup>1</sup>

**RELATED APPEALS AND INTERFERENCES**

Contrary to what the EXAMINER'S ANSWER says, an appeal is pending.

Applicant first filed its APPEAL in this case on April 26, 2001. The Examiner refused to file an EXAMINER'S ANSWER for several years.

Applicant accordingly petitioned the Court of Appeals for the Federal Circuit for relief. On June 16, 2004, the Court ordered the Director for Patents to appear in Court and explain the Examiner's refusal. See In re Knowles at 2 (Docket No. Misc. 767, 16 June 2004) (copy enclosed). Two weeks later, the Examiner filed her ANSWER.

Curiously, that ANSWER says, "The court, however, denied the mandamus petition and dismissed any appeal to the CAFC." See EXAMINER'S ANSWER at 3.

This is baldly incorrect. An appeal is pending before The Federal Circuit. See In re Knowles (Docket No. Misc. 767, 16 June 2004) (copy enclosed).

<sup>1</sup> N.B.: While the paper is styled a "SUPPLEMENTAL" ANSWER, it is the first and only ANSWER filed in this case.

Ok entered: Considered. Use 9/15/04

### ISSUES PRESENTED

The EXAMINER'S ANSWER proposes that "the issues should be directed to whether all the critical elements required by the instant claims including the specific concentration as claimed are taught by the cited references." EXAMINER'S ANSWER at 4.

5 Applicant disagrees. This issue was addressed - and resolved - during the six OFFICE ACTIONS reviewing the dozens of references of record in this case. The Office has already conceded that the references as a whole do not teach all elements of the instant claims.<sup>2</sup>

Therefore, the issue on appeal is not whether the references teach the instant claims; it is whether, given the factual findings of record in this case, the Office can now allege contradictory facts.<sup>3</sup> Applicant respectfully believes the Office cannot.

### GROUPING OF CLAIMS

The APPEAL BRIEF states that the claims are separately patentable.

The Examiner responds that this statement "is not clear." EXAMINER'S ANSWER at 5. The EXAMINER'S ANSWER, however, fails to say exactly what part of Applicant's language is "unclear."

Furthermore, the EXAMINER'S ANSWER itself shows how each claim is separately patentable. For example, the EXAMINER'S ANSWER urges the Board to group claims 1, 2 and 3 together. The EXAMINER'S ANSWER then concedes claim 2 is patentable over GIBSON; claim 3 is patentable over ZUPAN, and claims 1 and 3 are patentable over the SCHOSTAREZ combination. The EXAMINER'S ANSWER thus concedes that claims 1, 2 and 3 are separately patentable. The Board is therefore respectfully believed to lack the legal power to group the claims as the Examiner urges.

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<sup>2</sup> As a related matter, the EXAMINER'S ANSWER says that it "supercedes any previous office action." EXAMINER'S ANSWER at 2. This is incorrect. The EXAMINER'S ANSWER elaborates on, but cannot as a matter of law "supercede," the previous six OFFICE ACTIONS.

<sup>3</sup> The statement of Issues Presented provides an example of contradictory facts. The EXAMINER'S ANSWER says, "the limitation recited in the preambles (i.e. penetration to a depth of approximately the depth of hair bulbs) is considered to be an inherent feature which would naturally be achieved when the concentration of the penetration enhancer as claimed is met." EXAMINER'S ANSWER at 4. Three years ago, the Examiner conceded that this factual assertion is incorrect, and withdrew *en toto* the rejections relying on it. See OFFICE ACTION (28 Sept. 2001) at 2.

### PRIOR ART OF RECORD

The EXAMINER'S ANSWER relies on art different from that relied on in the most recent OFFICE ACTION.

The EXAMINER'S ANSWER relies on MIKULAK *et al.*, 50(2) J. PHARM. PHARMACOL. 153 (1998) (abstract only); ORENTREICH, United States Letters Patent No. 5,053,403<sup>4</sup>; and RAJADHYAKSHA, United States Letters Patent No. 5,482,965<sup>5</sup>. These three references were made of record several years ago. When Applicant pointed out their deficiencies, the Office conceded their failings. They are thus not mentioned in the most recent (20 Feb. 2003) OFFICE ACTION.

### ARGUMENT

#### The EXAMINER'S ANSWER Shows Why the Section 112 Rejection Must Be Withdrawn

The EXAMINER'S ANSWER withdraws the 35 U.S.C. 112 objection.<sup>6</sup>

The EXAMINER'S ANSWER establishes undisputed factual findings which show the Section 112 rejection must be withdrawn as a matter of law.

The only support for the Section 112 rejection is that "there is no pertinent teaching of retinoid penetration enhancer(s) ... in the original disclosure." EXAMINER'S ANSWER at 6, ¶ 10(a).

While this may be true, it is not a basis for a Section 112 rejection. The original disclosure need not teach retinoid penetration enhancer. The original disclosure *should not* teach this. Office procedure expressly discourages including this. The Specification should preferably omit material already known in the art. MPEP § 2164.01, *citing In re Buchner*, 929 F.2d 660,

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<sup>4</sup> EXAMINER'S ANSWER at 8.

<sup>5</sup> EXAMINER'S ANSWER at 15.

<sup>6</sup> The OFFICE ACTION (20 Feb. 2003) raised both a rejection and an objection under 35 U.S.C. 112. Office procedure says that when "there has been both a rejection and objection by the examiner, the [objection] becomes appealable and should not be decided by petition." MPEP (Feb. 2003) at § 2163.06(II). In the immediate case, while both the rejection and objection must be argued in an appeal, the EXAMINER'S ANSWER fails to object. Thus, the objection has been withdrawn.

661 (Fed. Cir., 1991) ("A patent need not teach, and preferably omits, what is well-known in the art.").

In the immediate case, the EXAMINER'S ANSWER alleges that retinoid penetration enhancers were known in the art. Because the Office alleges that retinoid penetration enhancers were known in the art, the Specification need not expressly teach this. *See id.* The Examiner's demand that Applicant do so is contrary to the Office's own procedure. *See id.*

Furthermore, the undisputed factual record shows the claims are allowable. Negative claim limitations are proper as long as "the boundaries of the patent protection sought are set forth definitely, albeit negatively." *In re Barr*, 444 F.2d. 588, 595 (C.C.P.A. 1971).<sup>7</sup> In the immediate case, the EXAMINER'S ANSWER says, "it would not be difficult to measure the scope of the claimed invention." EXAMINER'S ANSWER at 16. The EXAMINER'S ANSWER concedes that the boundaries of the protection sought are set forth definitely.

Therefore, the Section 112 rejection must be withdrawn.

#### BAZZANO

The EXAMINER'S ANSWER alleges facts which show that BAZZANO cannot anticipate the claims as a matter of fact.

#### *BAZZANO Expressly Teaches Away from the Claimed Invention*

BAZZANO teaches away from the claimed combination. APPEAL BRIEF at 9. The EXAMINER'S ANSWER does not dispute this.

Rather, the EXAMINER'S ANSWER says that BAZZANO "is capable of performing the intended use." EXAMINER'S ANSWER at 14. As support, the EXAMINER'S ANSWER cites to BAZZANO at column 20, lines 54 *et seq.* The cited text, however, fails to support the Examiner. It says, "for retinoic acid 1 mg/kg body weight/day is a maximal dose which will eventually cause toxicity and with chronic treatment *will probably cause the hair to fall out.*" *Id.* at col. 54, line 64 to col. 55, line 1 (emphasis added).

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<sup>7</sup> *See also*, *All Dental Prodx. LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774 (Fed. Cir. 2002) (a specification adequately complies with 35 U.S.C. 112, first paragraph, whenever it is reasonably clear what the invention is); *In re Wakefield*, 422 F.2d 897, 904 (C.C.P.A. 1970) (negative claim limitations can be used to "exclude the characteristics of prior art products.").

BAZZANO says long-term use of retinoic acid will "probably cause the hair to fall out."  
BAZZANO itself says it is not "capable of performing the intended use."

In contrast, the claimed invention requires a non-retinoid penetration enhancer. The  
claimed combination - unlike BAZZANO's retinoid combination - has been shown to be  
unexpectedly effective, even in long-term use. See SPECIFICATION at page 12, line 6 to page 14,  
line 7.

BAZZANO fails to teach every  
limitation of the claims

The EXAMINER'S ANSWER fails to allege that BAZZANO teaches *every limitation* of the  
claims. The EXAMINER'S ANSWER says that BAZZANO "teaches a method of treating alopecia."  
EXAMINER'S ANSWER at 7. This fails to state a *prima facie* case that BAZZANO teaches *the*  
*claimed* method.

The EXAMINER'S ANSWER points to BAZZANO at column 3, lines 60-65 and claim 13.  
That text says:

According to the invention it has been found that retinoids or mixtures thereof in  
combination with minoxidil and/or minoxidil-type compounds are synergistically  
effective in stimulating or increasing the rate at which hair grows on mammalian  
skin, prolonging the anagen phase of the hair cycle, converting vellus hair to  
terminal growth hair, and treating alopecias due to organic dysfunction of the hair  
follicle by topical application

Id. at column 13, lines 60-65. This teaches retinoid combined with minoxidil. This fails to teach  
"non-retinoid penetration enhancer" as is required by the claims. Claim 13 does no better, and  
also - as the Examiner has previously conceded - fails to *enable practicing* the claimed invention.

Progesterone

The art teaches that progesterone is not acceptable for the claimed combination. The  
Office has already conceded this, and withdrew the rejections raised in Paper No. 5.

The Examiner now tries to re-litigate this same argument. See EXAMINER'S ANSWER at 8,  
*citing* Paper No. 5 (OFFICE ACTION (31 Oct. 00)). This is illegal.

The record includes the following factual findings:

ORENTREICH teaches the topical use for hair loss of progesterone. ORENTREICH says progesterone has systemic side effects so serious that it should not be systemically administered for hair loss. ORENTREICH says, "The serious side effects (such as decreased libido) produced by the systemic administration of antiandrogens precludes the systemic use of these drugs for the treatment of the above skin disorders. For example, progesterone is a highly active 5 $\alpha$  reductase enzyme inhibitor, but systematically disturbs the menstrual cycle in women." *Id.* at col. 1 lines 45-51. ORENTREICH concludes that cardiac arrhythmias, feminization and impotency are side effects generally **not acceptable** for treating hair loss. ORENTREICH says these side effects **preclude systemic use** of these compounds for skin disorders. *Id.* at col. 1, lines 45-52. The Office has already conceded the correctness of the forgoing.

HOKE, United States Letters Patent No. 5,994,319, teaches that progesterone and minoxidil are unacceptable for hair loss. HOKE teaches that progesterone has severe adverse systemic effects like "feminization or impotency." *Id.* at col. 4 lines 18-23.

HOKE teaches that minoxidil doesn't work. *Id.* at col. 3, lines 4-11 ("only 8% of patients reported a dense re-growth of scalp hair"). HOKE also teaches that minoxidil has "potent" cardiovascular side effects. *Id.* at col. 3 lines 4-14. HOKE says minoxidil is "a potent anti-hypertensive" cardiac drug. HOKE says that systemic use of minoxidil can risk cardiac arrhythmias. HOKE at col. 5, line 4-6. HOKE teaches that minoxidil combined with a penetration enhancer may precipitate cardiac arrhythmias. *See* W.R. KNOWLES, *Rule 132 Declaration* at ¶¶3-7, 14-17. Thus, HOKE discourages using minoxidil *at all*, with or without penetration enhancer.<sup>8</sup> *Id.*

HOKE thus teaches away from the claimed combination of penetration enhancer with minoxidil or a testosterone blocker. The Office has already conceded this.

The claims require penetration enhancer combined with minoxidil or a 5 $\alpha$ -reductase inhibitor. HOKE and ORENTREICH thus teach that for hair loss, combining a penetration enhancer with minoxidil or progesterone is not worth the risk. They thus teach away from the

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<sup>8</sup> HOKE teaches using his patented nucleotides instead. HOKE says nucleotides are safe because they are "highly selective" genetic binders. They thus do not pose the systemic side effect risk seen with minoxidil or progesterone.

claimed combination. See W. Roy KNOWLES, *Rule 132 Declaration* (5 Feb. 2001) at ¶¶ 5-6, 14-17.

The Examiner has already conceded this. See, e.g., OFFICE ACTION (28 Sept. 2001) (withdrawing rejections based on ORENTREICH and HOKE).

5        BAZZANO Does not Enable The  
         Claimed Invention

BAZZANO actively teaches away from the claimed invention. BAZZANO teaches that systemic minoxidil presents serious cardiac side effect risks. *Id.* at col. 3 line 49-52; col. line 43-45. BAZZANO says that without added retinoid, *minoxidil does not work*. BAZZANO says:

10        Minoxidil is recognized as being somewhat effective in producing new vellus hair growth and sparse terminal hair growth in a pre-selected group of subjects. However, its effect is far from satisfactory in most subjects. \* \* \* minoxidil may not be able to sustain the growth of terminal hairs from the vellus hairs on the scalp. In the majority of subjects with alopecia, terminal hair growth on the scalp  
15        may not be initiated or sustained by the topical application of minoxidil nor by its systemic administration.

*Id.* at col. 3, line 53-56; col. 4, line 49-54. BAZZANO says that without her claimed retinoid compounds, minoxidil lacks any "profound effect" and "cannot" produce a strong response. *Id.*  
20        at col. 5, lines 17 - 42. BAZZANO explains that her claimed retinoids "can initiate cell growth and differentiation (not initiated by minoxidil)" required for hair growth. *Id.* BAZZANO says minoxidil alone "does not appear to be a sufficient stimulus for hair growth, particularly in an area affected by alopecia." *Id.* at col. 4, line 63-65.

Thus, BAZZANO teaches away from the claimed combinations. The Applicant -  
25        contrary to BAZZANO's teaching - has shown that minoxidil can be used effectively without addition of retinoid.

BAZZANO Does Not Teach  
         Penetration Enhancer

BAZZANO does not teach penetration enhancer.

30        The Examiner has already admitted this, but quipped that penetration enhancer "is not considered to be critical." OFFICE ACTION at 5 (Oct. 24, 2000). This argument fails because each claim element is, as a matter of law, "critical."

Now, the Examiner now attempts to contradict her earlier factual findings. The EXAMINER'S AMENDMENT alleges that the PEG-ethanol vehicle taught by BAZZANO is a penetration enhancer. This is a misrepresentation of the factual record.

BAZZANO calls PEG-ethanol a "vehicle." The word "vehicle" means "an inert substance (as syrup, lard, or liquid petrolatum) in a medicinal compound through which an active agent is administered or by which other ingredients are held together : diluent, excipient." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY at 2538 (Merriam-Webster Inc., 1986) (emphasis added) (copy attached); *see also* W. Roy KNOWLES, SUPPLEMENTAL DECLARATION at 1 (25 April 2001) (copy attached); SPECIFICATION at pg. 17, line 15-17, pg. 18, line 16 to pg. 19 line 9; 21 C.F.R. § 352.70 (Food & Drug Administration treats PEG as an inert vehicle) (copy attached); *cf.*, F.D.A.-approved product insert (PEG-ethanol used as an inert vehicle for ROGAINE® brand topical minoxidil) (copy attached).

BAZZANO teaches that PEG-ethanol is a "vehicle," an inert substance by definition. *See* WEBSTER'S DICTIONARY at 2538, *id.*

The EXAMINER'S ANSWER, however, carps that BAZZANO says PEG-ethanol is a "vehicle," not an "inert vehicle." EXAMINER'S ANSWER at 15. This is correct, but irrelevant; a vehicle is by definition inert. There is no need for BAZZANO to say it twice.

The EXAMINER'S ANSWER also says that "Rajadhyaksha[] Mikulak et al[], Zupan(US4440777, col.4, line 37), Gobson(US5015470, col. 14) are provided" to show that PEG-ethanol is a penetration enhancer. EXAMINER'S ANSWER at 15. The record, however, shows the opposite. Neither ZUPAN at col. 4, line 37, nor GIBSON at col. 14 mentions PEG-ethanol at all, much less the specific ratio PEG-ethanol blend used as a vehicle by BAZZANO.

Furthermore, both RAJADHYAKSHA and MIKULAK contradict "the examiner's allegation." This is why the Examiner withdrew reliance on these references two years ago.

**RAJADHYAKSHA**

RAJADHYAKSHA teaches improved trans-dermal drug delivery agents.

The Examiner has conceded that RAJADHYAKSHA teaches compounds that effectively deliver drugs into the systemic blood circulation. RAJADHYAKSHA at col. 2 line 16-19. The



Examiner has conceded that these compounds pass "through the skin and the systemic circulation" to the liver and yield nontoxic liver metabolites. Id. RAJADHYAKSHA says:

Typically systemically active agents which may be delivered transdermally are therapeutic agents which are sufficiently potent such that they can be delivered *through the skin or other membranes to the bloodstream* in sufficient quantities to produce the desired therapeutic effect. In general this includes agents in all of the major therapeutic areas including ... cardiovascular preparations including calcium channel blockers, beta-blockers, antiarrhythmics, antihypertensives, diuretics, vasodilators including general, coronary, peripheral and cerebral.

Id. at col.7 line 40-57. "Systemically active agents are used in amounts calculated to achieve and maintain *therapeutic blood levels* in a human or other animal." Id. at col. 3 line 53-60; col. 10 line 11-14 (emphasis added).

The Examiner has already conceded that RAJADHYAKSHA thus teaches using compounds for systemic drug delivery. Id. at col. 18 line 1-28. The Examiner has conceded that RAJADHYAKSHA's data show that his compounds do in fact make the drugs penetrate *completely though the skin*. Id. at col. 18 line 55 to col. 19 line 12 and Example 32; *see also*, W.Roy KNOWLES, *Supplemental Declaration*. RAJADHYAKSHA says:

Typically systemically active agents which may be delivered transdermally are therapeutic agents which are sufficiently potent such that they can be delivered *through the skin or other membranes to the bloodstream* in sufficient quantities to produce the desired therapeutic effect. In general this includes agents in all of the major therapeutic areas including ... cardiovascular preparations including calcium channel blockers, beta-blockers, antiarrhythmics, antihypertensives, diuretics, vasodilators including general, coronary, peripheral and cerebral.

Id. at col. 7 line 40-57.

The Examiner has already conceded that RAJADHYAKSHA does not teach delivering drugs "to the depth of the hair bulbs." To the contrary, the Examiner has already conceded that RAJADHYAKSHA teaches delivering drugs **completely through the skin**, into the systemic bloodstream. Id. at Example 32.

The Examiner has already conceded that RAJADHYAKSHA teaches delivering drugs to the systemic blood stream using a 5% concentration of 5-Amino-5-ethyl-2-(3-heptyl)-1,3-dioxane. Id. at Examples 28-30. The Examiner has already conceded that RAJADHYAKSHA

teaches delivering minoxidil to the blood stream using a 5% concentration of 5-Amino-5-ethyl-2-(3-heptyl)-1,3-dioxane. *Id.* at col. 15 line 26. (Perhaps because he feared the dangerous cardiac side effects, RAJADHYAKSHA avoided actually doing this example - it is just a prophetic example.)

5       The Examiner has already conceded that RAJADHYAKSHA teaches, at Example 29, a systemic birth control patch for delivering progesterone to the systemic blood stream. *See also* W. Roy KNOWLES, *Supplemental Declaration*. The Examiner has already conceded that the patch is not used in "alopecia or maintaining healthy hair," nor does it appear to deliver testosterone blocker "to a depth of approximately the depth of hair bulbs."       The Examiner  
10       has already conceded that for hair loss, RAJADHYAKSHA *teaches away from* combining penetration enhancers of any kind with minoxidil or testosterone blocker, due to adverse systemic side effects. The Examiner has already conceded that RAJADHYAKSHA does not enable the claimed invention. *See also* W. Roy KNOWLES, *Supplemental Declaration*.

15       The Examiner made these factual findings two years ago. The Office is respectfully believed prohibited from now re-litigating these factual findings.

*MIKULAK et al.*

MIKULAK *et al.*, 50(2) J. PHARM. PHARMACOL. 153 (1998) (abstract only), discloses a new skin penetration agent called "TPDS."

The record shows the following undisputed factual findings:

20       The Examiner has already conceded that MIKULAK compares TPDS to two other methods of drug administration. The Examiner has already conceded that MIKULAK compares TPDS to (1) PEG-ethanol as the experimental control, (2) an unnamed, albeit "commonly used" skin penetration enhancer, and (3) oral administration. *Id.* ("We compared the TPDS with a 50:50 (vol./vol.) mixt. of propylene glycol and ethanol, a commonly used penetration enhancer,  
25       and with oral administration."). The Examiner has already conceded that MIKULAK teaches that polyethylene glycol is an (inert) vehicle used as the experimental control, not a skin penetration enhancer.

Furthermore, assuming that MIKULAK's 50:50 PEG-ethanol blend were a penetration enhancer, the Examiner has already conceded that BAZZANO fails to teach the use of such a 50:50 blend.

The Examiner has already conceded the forgoing, and withdrew reliance on MIKULAK. *See, e.g.*, OFFICE ACTION (9 May 2002) (withdrawing rejections based on MIKULAK; OFFICE ACTION (20 Feb. 2003). The Office is respectfully believed bound by its own prior factual findings.

The EXAMINER'S ANSWER now alleges that "Gibson or Zupan specifically exemplifies number of compounds listed as penetration enhancers which shares common chemical structures." EXAMINER'S ANSWER at 16. This assertion is both baseless and incorrect. It is baseless because the record is devoid of any evidence at all showing that the compounds share a "common chemical structure."

It is incorrect because the compounds in fact have widely-divergent chemical structures. For example, GIBSON at col. 14 lists both acetone ( $C_3H_6O$ ) and diisopropyl sebacate ( $C_{36}H_{30}O_4$ ), compounds which have widely-divergent chemical formulae, as well as structures.

The EXAMINER'S ANSWER Fails to State a *Prima Facie* Case that GIBSON Anticipates

GIBSON, United States Letters Patent No. 5,015,470, teaches inhibiting enzymes which interfere with hair growth.

The EXAMINER'S ANSWER argues that GIBSON "teaches a topical composition for maintaining and increasing hair growth comprising minoxidil and a penetration enhancer." EXAMINER'S ANSWER at 8. As support, the EXAMINER'S ANSWER cites to GIBSON Table 1, the Abstract, and col. 4, lines 40-42. The cited text, however, fails to support the Examiner.

Table 1 compares a topical vehicle (70% ethanol, 20% water and 10% propylene glycol) alone to vehicle containing 2% (w/v) minoxidil. Id. at col. 20, lines 9-26. Table 1 uses PEG-ethanol as the inert experimental control.

The Abstract says, "A composition suitable for topical application to mammalian skin or hair for inducing, maintaining or increasing hair growth comprises: (i) a first chemical inhibitor chosen from proteoglycanase inhibitors, glycosaminoglycanase inhibitors,

glycosaminoglycan chain cellular uptake inhibitors or The Abstract fails to teach a non-retinoid penetration enhancer combined with a testosterone blocker nor minoxidil.

Column 4, lines 40-44 teaches combining minoxidil with a specific kind of penetration enhancer. This text fails, however, to teach nor enable penetration enhancer to deliver testosterone blocker nor minoxidil to the hair bulbs.

The EXAMINER'S ANSWER fails to address the failings in GIBSON which are raised in the APPEAL BRIEF.

GIBSON Combined With BAZZANO  
and SCHOSTAREZ Does Not Render  
Obvious The Claimed Invention

The EXAMINER'S ANSWER says the claimed invention is obvious over GIBSON combined with BAZZANO and with SCHOSTAREZ. This rejection must be withdrawn, because the EXAMINER'S ANSWER fails to state a *prima facie* case of obviousness.

A *prima facie* case of obviousness requires the Examiner to identify some suggestion to combine the references. This suggestion to combine must appear somewhere in the art of record. In re Lee, 277 F.3d 1338, 1344 (Fed. Cir., 2002); *cf.* In re Dillon, 919 F.2d 688, 692 (Fed. Cir., 1990) (the suggestion to combine must be in the art of record, albeit the art may teach a use different than the claimed use).

In the immediate case, the EXAMINER'S ANSWER fails to identify any suggestion to combine anywhere in the voluminous references or record. To the contrary, the Examiner concedes that the voluminous art of record expressly teaches away from making the claimed combination.

For example, SCHOSTAREZ, United States Letters Patent No. 5,373,012, teaches 5-fluoro substituted minoxidil. The Examiner has conceded that SCHOSTAREZ quantifies the cardiac side-effects of each compound, showing that they have similar dose-dependent effects on mean arterial pressure, Fig. 1, and on changes in heart rate, Fig. 2. The Examiner has conceded that SCHOSTAREZ further shows that 5-fluoro substituted minoxidil penetrates completely through the skin and into the systemic blood circulation over three times more quickly than plain minoxidil, *see* SCHOSTAREZ at Table IV - creating three times the incidence of adverse systemic side effects.

In lieu of a suggestion to combine somewhere in the art of record, the EXAMINER'S ANSWER makes a factual assertion which is both baseless and, if true, demonstrates non-obviousness of the combination.

5 The EXAMINER'S ANSWER says that one would be motivated to combine the references because each component "utilize[es] different biological pathway and potentiat[es] other component's activity." EXAMINER'S ANSWER at 11. The EXAMINER'S ANSWER fails, however, to offer any evidentiary basis for this assertion (*i.e.*, the Examiner fails to allege what the "different biological pathways" involved here are, nor how the references teach these pathways). This allegation cannot be used to reject any claim because it is baseless.

10 It also directly contradicts the Examiner's previous assertion that the claimed components "have the same biological pathway( working via same mechanism)." OFFICE ACTION at 5 (31 Oct. 2000).

15 Further, assuming the claim components use "different biological pathways" as the EXAMINER'S ANSWER alleges, this shows the combinations are non-obvious. This is because the Office has already taken the position that similar biological pathways evince a motivation to combine. OFFICE ACTION at 5 (31 Oct. 2000). The Office cannot have it both ways; if similar pathways suggest an obvious combination, then different pathways must suggest a non-obvious combination.

20 The EXAMINER'S ANSWER also says, "each patentee (Bazzano or Schostarez) teaches that 5 alpha reductase inhibitor ... can be used effectively in combination with minoxidil to improve its antialopecia effects." EXAMINER'S ANSWER at 10. This fails to state a *prima facie* case, because the claimed combination is not 5 alpha reductase inhibitor combined with minoxidil. The claimed combination is *non-retinoid skin penetration enhancer* combined with 5 alpha reductase inhibitor or with minoxidil (or both). The Examiner has already conceded that both  
25 BAZZANO and SCHOSTAREZ teach away from combining skin penetration enhancer with 5 alpha reductase inhibitor or minoxidil.

Regarding claims 7-10, 16 and 18-21, it is undisputed that SCHOSTAREZ shows that the 5-flouro compound inherently penetrates through the skin and into the systemic circulation -

precipitating cardiac side effects. It is undisputed that neither SCHOSTAREZ nor GIBSON propose any solution to prevent this.

Nonetheless, the EXAMINER'S ANSWER asserts that "[t]he determination of effective dosage regiments required by [claims 7-10, 16 and 18-21] are considered to be within the level of the ordinary skilled artisan, and because the minor variations including the selection of optimal dosages or variable applications in order to determine the most effective treatment is commonly practiced and obvious." EXAMINER'S ANSWER at 11. Applicant respectfully disagrees, because the art of record teaches the exact opposite.

The art of record does not teach the claimed ratios are "commonly practiced." To the contrary, the art of record teaches against practicing the claimed combination at all, in any ratio. *See. e.g.,* ORENTREICH, HOKE and SCHOSTAREZ (each discussed above), and BRADBURY, PARTIAN and KITA (each discussed in the prior prosecution history and since withdrawn as references). Tellingly, the EXAMINER'S ANSWER fails to say where any reference teaches the claimed ratios. In six OFFICE ACTIONS and an EXAMINER'S ANSWER, the Examiner has never introduced any evidence showing the claimed ratios are known in the art at all, much less "commonly practiced," nor that "selection of an optimal dosage" would have been obvious.

Because the record is devoid of any evidence showing that the specific ratios of claims 7-10, 16 and 18-21 were known in the art at all, the EXAMINER'S ANSWER has failed to state a *prima facie* case of obviousness.

The EXAMINER'S ANSWER says that SCHOSTAREZ teaches that 5-fluoro minoxidil "is admixed with 5 alpha reductase inhibitor (i.e. finasteride) beneficially for treating alopecia, see column 3, lines 49-57." EXAMINER'S ANSWER at 10. The cited text, however, merely confirms the teaching of the other references that combining minoxidil with a penetration enhancer risks precipitating cardiac side-effects. It says, "The invention also relates to compounds as described in Formula I, and combinations with antiinflammatories (steroidal and non-steroidal), androgen receptor blockers, 5 $\alpha$ -reductase inhibitors, and -blockers for the treatment of cardiovascular disorders, such as hypertension, congestive heart failure, and angina, peripheral vascular disorders, and the treatment of alopecia." *Id.* at col. 3, lines 49-55. Similarly, SCHOSTAREZ at col. 4, lines 45-50 simply says that the use of penetration enhancers

"may be beneficial." This is a suggestion to pursue further experimentation - not an enabling art reference.

ZUPAN Fails to Enable the Claimed Invention

The EXAMINER'S ANSWER argues that "the claimed subject matter is inherently met by" ZUPAN. As support, the EXAMINER'S ANSWER cites ZUPAN at column 3, lines 17 - 35. That text reads as follows:

Another object of the invention is to provide an enhancing agent which is devoid of toxic side effects.

Yet another object of the invention is to provide novel compositions utilizing such novel enhancing agents, which formulations are useful for topical application.

Still another object of the present invention is to provide a method for enhancing the skin penetration of bio-affecting materials.

Other objects, features and advantages of the invention will be apparent to those skilled in the art upon a study of the disclosure and the appended claims.

It has now been unexpectedly discovered that the aforementioned objects can be achieved by employing eucalyptol as the enhancing agent and by employing same in a composition of matter further comprising at least one bio-affecting agent. The compositions can also further comprise a topical carrier material and/or an additional penetration enhancer.

This is an invitation experiment. It fails, however, to teach minoxidil, nor 5 $\alpha$ -reductase inhibitor, nor skin penetration enhancer, nor penetration to a depth of hair bulbs. See Knowles, W.R., RULE 132 DECLARATION (5 Feb. 2001).

SUMMARY

Applicant respectfully believes that the rejections must each be reversed as a matter of law.

Respectfully submitted,

5  
10  
  
Mark POHL, Reg. No. 35,325  
31 August 2004

PHARMACEUTICAL PATENT ATTORNEYS, LLC  
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mbc:mp

20 Enclosures:

In re Knowles, Docket No. Misc. 767 (Fed. Cir., 16 June 2004)  
MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (10<sup>th</sup> ed.) page 1309  
W.R. KNOWLES, SUPPLEMENTAL DECLARATION at 1 (25 April 2001)

25  
30  
35  
SD:\Knowltech\Hair Loss\09.619,142 Reply Brief (30 Aug. 2004).doc

ENCLOSURES



UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT



Official Caption<sup>1</sup>

Miscellaneous Docket No. 767

SEP - 8 2004

LCR CENTER 1600/2900

IN RE W. ROY KNOWLES, M.D.,

Petitioner.

On Writ of Mandamus from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences, in 09/619,142.

Authorized Abbreviated Caption<sup>2</sup>

IN RE KNOWLES, MISC. 767

<sup>1</sup> Required for use on petitions, formal briefs and appendices, court opinions, and dispositive court orders. FRAP 12(a); 32(a).

<sup>2</sup> Authorized for use only on items not requiring the Official Caption as listed in note 1.

NOTE: Pursuant to Fed. Cir. R. 47.6, this order  
is not citable as precedent. It is a public order.

# United States Court of Appeals for the Federal Circuit

MISCELLANEOUS DOCKET NO. 767

IN RE W. ROY KNOWLES, M.D.,

Petitioner.

ON PETITION FOR WRIT OF MANDAMUS

Before RADER, Circuit Judge.

## ORDER

W. Roy Knowles, M.D. petitions for a writ of mandamus to direct the examiner of his patent application to forward Knowles' appeal brief to the Board of Patent Appeals and Interferences.

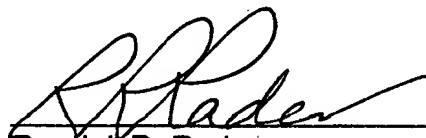
About one year ago, Knowles filed a similar mandamus petition complaining that the examiner was thwarting his attempts to appeal to the Board. In our order denying the mandamus petition, we stated that the Director had informed Knowles of the steps he should take to obtain Board review. He followed those instructions, but now informs us that the examiner has not taken any action.

Upon consideration thereof,

IT IS ORDERED THAT:

The Director is directed to respond within 60 days.

15/6/04  
Date

  
Randall R. Rader  
Circuit Judge

cc: J. Mark Pohl, Esq.  
John Whealan, Esq.

s5

**FILED**  
**U.S. COURT OF APPEALS FOR**  
**THE FEDERAL CIRCUIT**

**JUN 15 2004**

**JAN HORBALY**  
**CLERK**



# Merriam- Webster's Collegiate® Dictionary

TENTH EDITION

Merriam-Webster, Incorporated  
Springfield, Massachusetts, U.S.A.

c : caused by or resulting from the operation of a vehicle

V-8 \v'e-'ät\ n (1942)  
banks of four cylinders each with the same  
automobile having such an engine

**'veil** ('vā(ə))\ n [ME *veile*, fr. OFr. *veile*, fr. L. *velum*, 'cloth'] (13c) **1** a : a length of cloth worn by women over their shoulders and often esp. in Eastern countries as a sign of modesty or mourning **b** : a length of material attached for protection to the front of a machine or vehicle

**face; specif :** the outer covering of a face or face or attachment  
**c :** any of various liturgical cloths  
**e :** the cloistered life of a nun  
**f :** something that hides

esp : a cloth used to cover the chalice 4 : something that  
covering body part or membrane: as a: v

3: a concealing  
obscures like a veil 5: a covering  
LUM. b: CAUL to cover, provide, obscure, or conceal with or as if with a veil

veil vt (14c): to cover or wear a veil  
veil ~ vi: to put on or wear a veil  
veil ~ va(ə)ld\ adj (1593) 1 a: having or wearing a veil  
b: characterized by a softening tonal dis-  
tinction (~ threats)

cealing cover (a ~ hat) 1: VEIL 2: any of various light shades  
tion 2: obscured as if by a veil: DISGUISED (14c) 1: a: a na

**'vein** \vān\ *n* [ME *veine*, fr. OFr *veine*, fr. *vena*] 1 : a natural water channel in rock or earth or in ice 2 : BLOOD VESSEL; esp : any of the larger vessels that carry blood from the capillaries toward the heart

of useful mineral matter  
branching vessels that carry blood from the heart to the various parts of the body; any of the vascular bundles forming the framework of some plants; any of the thickened cuticular ribs that serve to stiffen the walls of certain insects; any of the branching veins (as in reticulate venation) in the leaves of many plants.

leaf b : any of the thickened, flattened, expanded parts of a plant stem or branch that are adapted for photosynthesis and transpiration 4 : something suggesting a leaf or leaves 5 a : a distinctive mark or quality : STRAIN b : a distinctive mark or quality : STRAIN

specif: a wavy line    b: a pervasive  
expression: STYLE    6 a: a special aptitude:  
line of thought or action    c: top form: FERTILE

**a** \ˈvā-nē\ *adj*  
 (1507); to pattern with or as if with veins  
 (1529); patterned with or as if with vein  
 (1538) (*vēn*) (~ cheese)

**veined** 'vænd\ adj (ca. 1527) (< ~ marble, ~ leaf)  
ing venation: STREAKED (a ~ leaf) < ~ marble, ~ leaf  
n (1895): a small V gouge used in wood carving  
n (1895): a pattern of veins: VENATION

vein-er \ 'vā-nēr \ n (1826): a part of a vein  
vein-ing \ 'vā-nīŋ \ n (1831): a small vein  
vein-let \ 'vān-lət \ n (1831): a small vein  
veiny \ 'vā-nē \ adj (1811): full of veins: noticeably veined

**ve-lā-men** \və-'lā-mən\ *n*, pl **ve-lā-men** (1882) : fr. *velare* to cover, fr. *velum* curtain

TABLE 2  
the atmosphere

**ve-lar** \ve-lär\ *n* 1: the part of the  
back of the tongue touching or near  
2: of, forming, or relating to a velum and esp. the

**ve-lar-i-um** \vi-'lar-ē-əm, -'ler-\ *n.* pr -12  
an awning over an ancient Roman theater or amphitheater  
1: the quality of being velarizing

ve-lar-i-za-tion \,və-lă-rī-zā-shən/ 2: an act or instance of velarizing  
being velarized 2: an act or instance of velarizing (1915): to modify  
-iz-ing (1915): to modify

**ve-lar-ize** \ve-'lar-īz(ə)-  
\-'pül\ pool) by a simultaneous velar  
**vel-cro** \vel-(,)krō\ trademark — used for a closure consisting of small hooks that sticks to a correspond-

piece of fabric of small loops  
small loops  
veldt \ 'velt, 'felt\ *n* [Afrik veld, fr. D. field, *usu.* of southern Africa]

veld or veldt [NL, fr. *velum* + *-ger* bearing  
field] (1835): a grassland esp. with  
shrubs or trees

ve-li-ger \ve-liz-jer/ (1877): a larval mollusk in the lowest degree of

**vel·le-i-ty** \ve-'lē-z-le-, vō-'lē-z-le-  
will — more at WILL\ (1618) 1: the lower  
wish or tendency : INCLINATION  
MF *veelin*, fr. MF *veelin*, fr. *veelin*

**veal** \ve-ləm\ *n* [ME *veine* *fr.* *veel* calf — more at **VEAL**] (15c) 1: a fine-grained flesh of a young bovine animal prepared esp. for writing on or for

2: a strong cream-colored paper

**ve-lo-ce** \vā-'lō-(j)chā\ *adv* or *adj* [L, It. *veloce*]  
 rough (paper with a ~ finish) — used as a direction in music  
*ve-lo-ci-tas* — used as a direction in music [velocity + *-tas*]  
*ve-lo-ci-ty* — used as a direction in music [velocity + *-ty*]  
*ve-lo-ci-ty* — used as a direction in music [velocity + *-ty*]

**ve-lo-cim-e-ter** \vĕ-lō-sī-mē-tēr\ *n* [F *vélocipède*, fr. L *velox* 'swift' + *cipēs* 'foot'] : a lightweight wheeled device for measuring speed (as of fluid flow or a vehicle)

ve-lo-ci-pe-de (Vĕ-lō'pēd) (1816) : a  
pes foot — more at FOOT] (1816) :  
pedaled by the rider: as a archaic : BICYCLE  
called by the rider: as a archaic : BICYCLE

(1639) archaic  
ve·loc·i·ty \və-ˈlās-tē, -ˈlās-tē/ n. pl. -ties  
wheeled railroad handcar  
fr. veloc-, velox quick; prob. akin to L. v  
-ity fr. veloc-, velox quick; prob. akin to mo  
-ity fr. veloc-, velox quick; prob. akin to mo  
-ity fr. veloc-, velox quick; prob. akin to mo

(1955) 1: VEGE-  
more at WAKE] (ca. 1550)  
of sound) b: rapidity of movement {tiny  
and comeliness, rather than ~ — Mark Twain

parted to something (the power of the state of being

time : the derivative  
occurrence or action : RAPIDITY (the  
narrative leaps from one frantic episode  
to the next) (the narrative Atlas) b : rate of turnover

ve-lo-drome \v'e-lə,drōm, 've-, 'və-lə- (1895): a track for racing velocipède) + -drome] (1895): a track for racing

**ve-lour** or **ve-lours** (\və-'lʊr; -'lɔːr) (short for velvet), fr. OF velours, fr. MF velours, velour, fr. LL vellus shaggy hair — more at

losus shaggy, n: wild

about	kitchen	easy
chicken	bet	thin
out	law	boy
		see

17) sing 101 go 101  
 18) yet 121 vision 121, k, n, æ, œ, ʊ, ɔ, ɛ

of, relating to, or ac-

MERRIAM-W  
SPRINGFIELD

laùt out    ləi law    ləi boy    ləi thin    ləi the    ləi look

lyl sing lol go  
lyl yet lzh vision lā, k, n, æ, œ, ʉ, ɔ,

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MERRIAM-WEBSTER  
SPRINGFIELD, MA 01102

IN THE UNITED STATES PATENT OFFICE

FILE COPY

Inventor : W. Roy KNOWLES, M.D.  
Filing Date: 19 July 2000  
Ser. No.: 09/619,142  
Art Unit: 1614  
Examiner: Vickie KIM

SUPPLEMENTAL DECLARATION UNDER RULE 1.132

- 1) I am the inventor of record for the captioned patent application. I make this Declaration under 37 Code of Federal Regulations Rule 1.132.
- 2) Bazzano. I have read Bazzano, United States Patent No. 5,183,817. Bazzano teaches that PEG-ethanol mixtures are inert cosmetic carrier vehicles. Bazzano says, at column 19, lines 66-68, that "lotions may be prepared using various forms of alcohols or other solubilizers such as glycols or esters." Bazzano here simply reiterates the conventional wisdom that glycols (such as PEG) ethanol are useful "solubilizers"; that is, as an inert diluent or vehicle, without skin penetration efficacy on their own.
- 3) Bazzano discusses using PEG-ethanol as an inert "vehicle" and as a "placebo." Bazzano at col. 21-24 and claims 23-24. Researchers skilled in the art recognize these terms indicate compounds that have no skin permeability or skin penetration efficacy on their own.

- 4) Bazzano's Example I, at column 24, teaches using PEG-ethanol as the vehicle for topical minoxidil administration. This formulation appears simply to have been copied from that for Pharmacia & Upjohn's formulation for their commercially-available ROGAINE® product, which uses PEG-ethanol as the vehicle.
- 5) Mikulak. I have reviewed the abstract provided by the Examiner. I find it uncontroversial. The abstract appears to describe a test of a new skin penetration agent called TPDS. The abstract uses PEG-ethanol (50:50), apparently as the experimental control, and compares it against TPDS, a "commonly used skin penetration enhancer" and oral administration. This abstract confirms that Mikulak et al. consider PEG-ethanol not a skin penetration agent; if it were, Mikulak would have needed to use a different, inert compound as the experimental control.
- 6) Rajadhyaksha. I have reviewed United States Patent No. 5,482,965. It teaches transdermal drug delivery agents useful for the delivery of drugs through the skin and into the systemic blood circulation. The reference highlights the claimed compounds' systemic safety, such as the systemic safety of the breakdown products.

- 7) This is supported by the examples. Example 32 shows a standard skin-penetration activity assay. The results of Example 32 show that the disclosed compounds do indeed work as exceptional skin permeability enhancers, carrying drug compounds entirely through the tested skin samples. This indicates that the same compounds, if used in vivo, would provide excellent drug delivery completely through the skin and into the systemic blood circulation.
- 8) The reference teaches using 5-amino-5-ethyl-2-(3-heptyl)-1,3-dioxane ("A5A") as a skin permeability enhancer. Examples 28-30 disclose using A5A at a 5% concentration. The drugs of Examples 28 and 30 are only used systemically. Thus, I conclude that the 5% A5A concentration used effects systemic delivery of the drugs. Thus, I conclude that Example 29, a progesterone skin patch, effects systemic delivery of progesterone through the skin and into the systemic blood circulation. Example 29 is therefore a birth control skin patch.
- 9) Similarly, Example 18 teaches administering minoxidil using 5% A5A. As mentioned above, the reference teaches 5% A5A is useful for the administration of drugs through the skin into the systemic blood circulation. Example 18 does nothing to

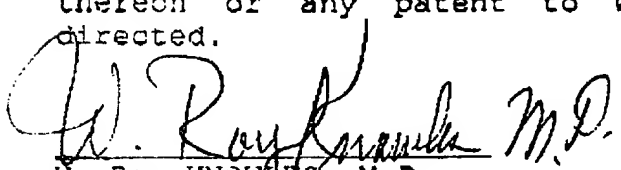


W.R. KNOWLES, M.D.  
Ser. No.: 09/619,142  
Supplemental Declaration

teach how to deliver minoxidil to the level of the hair bulbs, nor how to avoid delivery of the minoxidil into the systemic blood circulation, nor how to avoid cardiovascular side effects of such systemic drug delivery.

- 10) Therefore, nothing in the reference enables the claimed invention. Specifically, nothing enables one of skill in the art to practice "penetration enhancer present in a concentration sufficient to aid said active compound in penetrating the skin surface to a depth of approximately the depth of hair bulbs."

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United State Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon or any patent to which this verified statement is directed.

  
W. Roy KNOWLES, M.D.  
April 25, 2001

X:\pohln\Knowles\Supplemental Declaration